

REMARKS

I. Status of the Claims

Claims 18, 20-28 and 30-51 are pending in this application. Independent claims 18, 47, 49 and 50 were amended to recite that the C₁₈ fatty alcohol and the C₂₂ fatty alcohol "are present in a ratio of 0.15 to 20." Support for this amendment can be found, for example, at page 6, lines 11-14 of the specification as originally filed and thus do not raise an issue of new matter.

II. Personal Interview

Applicants wish to thank Examiners Yu and Padmanabhan for granting Applicants' representatives, Mark Sweet and Harry Gutman, the courtesy of an interview conducted June 29, 2005. During this interview, Applicants' representatives discussed with the Examiners the rejection of record under 35 U.S.C. § 103, and emphasized the differences between the present invention and the compositions according to WO 99/13830 to Mitsumatsu et al. ("Mitsumatsu") and WO 98/03155 to Sebag et al. ("Sebag"). Specifically, Applicants' representatives explained that no motivation existed in the prior art of record that would support the modifications suggested by the Examiner.

As indicated in the Interview Summary, the ratio of the C₁₈ fatty alcohol to the C₂₂ fatty alcohol was also discussed. Specifically, Applicants' representatives submitted that the recitation of a C₁₈ fatty alcohol / C₂₂ fatty alcohol ratio of from 0.15 to 20 would further distinguish the claimed invention from the compositions disclosed in Mitsumatsu and Sebag. Further to this discussion, Applicants have amended the claims, as suggested by the Examiners, to recite that the C₁₈ fatty alcohol and the C₂₂ fatty alcohol "are present in a ratio of 0.15 to 20." See, e.g., claim 1.

III. Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 18, 20-28 and 30-51 under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu in view of Sebag for the reasons disclosed at pages 2-4 of the Office Action dated August 11, 2005. Applicants respectfully traverse this rejection for at least the reasons presented below.

In order to establish a *prima facie* case of obviousness, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." *See In re Fine*, 837, F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Specifically, the Examiner must meet three basic criteria. First, the prior art references, taken alone or in combination, must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. And finally, there must be a reasonable expectation of success. *See M.P.E.P. §§ 2143.01-03.*

It is not sufficient to merely "find every element of a claimed invention in the prior art [and for] an examiner to use the claimed invention itself as a blue print for piecing together elements Such an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations and quotations omitted). In the present case, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness at least because the references fail to teach or suggest each and every element recited in the pending claims.

A. Alcohol Components

Focusing first on the alcohol components recited in the independent claims, Applicants respectfully submit that Mitsumatsu fails to teach or suggest, for example, the amount of the C₁₈ fatty alcohol recited in the claim, i.e., “an amount by weight ranging from 0.3% to 10%,” and the C₁₈ fatty alcohol / C₂₂ fatty alcohol ratio, i.e., “a ratio of from 0.15 to 20.” The Examiner acknowledges that Mitsumatsu does not disclose example formulations that “concurrently use stearyl alcohol and behenyl alcohol within a same composition as recited in the instant claims.” See Office Action at page 2. But the Examiner points to page 24, lines 19 and 20 of Mitsumatsu, which discloses that “[n]onlimiting examples of fatty alcohols include, cetyl alcohol, stearyl alcohol, behenyl alcohol, and mixtures thereof,” as well as Examples 4 and 5 of Mitsumatsu in an attempt to meet these weight and ratio values. *See id.* at pages 2 and 3. These passages in Mitsumatsu, however, merely provide at best general guidance to use a mixture of alcohols, but fail to suggest both 1) the C₁₈ fatty alcohol weight percentage and 2) the C₁₈ fatty alcohol / C₂₂ fatty alcohol ratio recited in the claims.

Mitsumatsu fails to disclose a composition comprising a C₁₈ fatty alcohol in “an amount by weight ranging from 0.3% to 10%,” as recited in the independent claims. The Examiner’s reliance on Examples 4 and 5 of Mitsumatsu fails to take into account the fact that the amount of stearyl alcohol, i.e., the C₁₈ fatty alcohol, used in these examples is less than the claimed amount. Additionally, the Examiner’s reliance on the cetyl alcohol / stearyl alcohol ratio in Examples 4 and 5 of Mitsumatsu as the motivation to substitute behenyl alcohol for cetyl alcohol ignores the fact that such a substitution

will still not result in a composition as recited in the independent claims. Again, the amount of stearyl alcohol is outside the scope of the present claims.¹

As this is the only specific guidance in Mitsumatsu with respect to the amount and ratio of the various alcohols contained in the compositions of Mitsumatsu, it is not seen how examples that fall outside the scope of the present claims coupled with a general disclosure that is silent with respect to any amounts and ratios could lead one of ordinary skill in the art to make the modifications necessary in an attempt to arrive at the compositions recited in the present claims. Simply put, the guidance provided by Mitsumatsu would, at best, result in a combination of alcohols that would fall outside the scope of the present claims.

Sebag, which is relied upon for its disclosure of “the opacifier/pearlescent recited in claims [20]²-25” (Office Action at page 3), fails to remedy deficiencies in Mitsumatsu with respect to the alcohol components. Accordingly, Mitsumatsu in view of Sebag fails to suggest the claimed invention at least for this reason.

B. Opaciers and/or Pearlescent Agents

Focusing now on the Examiner’s reliance on Sebag, Applicants submit that one skilled in the art would not have been motivated to modify Mitsumatsu in view of Sebag. Mitsumatsu teaches shampoo formulations comprising trizole as an essential ingredient, with additional optical brighteners available “which have the same characteristics as the triazoles with respect to ultraviolet light absorption and visible light emission.”

¹ According to the Examiner, “the Mitsumatsu Examples do not show the recited weight range of the fatty alcohols [of claims 26-31].” Office Action at page 3. For the reasons stated above, Applicants submit that the Mitsumatsu Examples also do not show the weight range of the fatty alcohols recited in all the independent claims.

² Applicants note that claim 19 was canceled in the Amendment filed February 4, 2004.

Mitsumatsu, col. 39, lines 1-2. Mitsumatsu does not include opacifiers or pearlescent agents among the lengthy list of other additional components. *Id.* at col. 41, lines 9 - 28.

One skilled in the art would recognize that optical brighteners and opacifiers differ in their mechanism and function. Optical brighteners, also referred to as fluorescent whitening agents, “absorb the invisible uv portion of the daylight spectrum and convert this energy into the longer-wavelength visible portion of the spectrum.” See, e.g., McElhone, Jr., Harold J., “Fluorescent Whitening Agents,” Kirk-Othmer Encyclopedia of Chemical Technology (1994), at <http://www.mrw.interscience.wiley.com/kirk/articles/fluomcel.a01/sect11.html>. Optical brighteners can be used to “compensate for the aesthetically undesirable yellowish cast found in white industrial substrates, such as textiles, papers, or plastics.” See, e.g., Siegrist, Adolf Emil, “Optical brighteners: 1. Introduction,” Ullman’s Encyclopedia of Industrial Chemistry (2002) at http://www.mrw.interscience.wiley.com/ueic/articles/a18_153/abstract.html.

In contrast, opacifiers may be included in the formulation of a “surfactant solution at temperatures above their melting points and then crystallize upon cooling, producing a pearlescent appearance.” See Reiger, Martin M., Ph.D., “Opacifying and Clarifying Agents,” Harry’s Cosmeticology, 8th Ed., Chemical Publishing Co., Inc., New York (2000) p. 623. The total opacifying effect “is dependent on the crystal size, distribution and reflectance.” *Id.*

In other words, optical brighteners achieve a brightening effect through fluorescence, while opacifiers achieve a pearlescent appearance through reflectance or

light scattering. Applicants respectfully submit that optical brighteners and opacifiers/pearlescent agents differ in mechanism and function.

Applicants respectfully submit that the Examiner has not cited sufficient objective evidence that would have led one skilled in the art to substitute an opacifier for the optical brightener claimed in Mistumatsu. Mitsumatsu does not suggest such a substitution. Instead, Mitsumatsu indicates that the uv light absorption and visible light emission characteristics of the trizole and additional optical brighteners are essential to the invention claimed in Mitsumatsu. Sebag does not suggest such a substitution. Sebag does not even suggest that dialkyl ether is responsible for the pearlescent appearance of the disclosed composition. Without any suggestion or motivation, one skilled in the art would not have modified Mitsumatsu in view of Sebag with a reasonable expectation of success.

Accordingly, Applicants submit that the Examiner has failed to demonstrate a *prima facie* case of obviousness and request that the § 103(a) rejection be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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